

Regarding the specification, Applicants have amended the specification as indicated above to correct a typographical error. Applicants attach herewith an Appendix that includes a marked-up version of the amendment to the specification, designated "Version of Specification with Markings to Show Changes Made," detailing the change made. The amendment to the specification includes no new matter, in conformance with 37 C.F.R. § 1.125(b)(1).

Regarding the Office Action:

Claims 1 – 18 are pending. In the Office Action, the Examiner objected to claim 11 for informalities; rejected claims 5 and 8 under 35 U.S.C. § 112, 1st paragraph, as allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention; rejected claims 7 and 9 under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite; rejected claims 1, 2, 13, 17, and 18 under 35 U.S.C. § 102(b) as anticipated by Yukihiro (Japanese Patent Publication No. 09-055607) ("JP '607"); advised Applicants of "the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at a time later that the invention was made" (Office Action, p. 4); rejected claims 3 and 9 under 35 U.S.C. § 103(a) as unpatentable over JP '607 in view of Akito, et al. (Japanese Patent Publication No. 04-172702) ("JP '702"); rejected claims 4 – 8 and 16 under 35 U.S.C. § 103(a) as unpatentable over JP '607 in view of Yamamoto, et al. (U.S. Patent No. 5,900,789) ("Yamamoto"); and rejected claims 10 – 12, 14, and 15 under 35 U.S.C. § 103(a) as unpatentable over JP '607 in view of Marusawa, et al. (U.S. Patent No. 5,744,024) ("Marusawa").

Applicants appreciate the Examiner's thorough examination of this application, especially the detailed citations which aided Applicants in reviewing the Examiner's comments. Applicants respectfully traverse the objections and rejections, as detailed above, for the following reasons.

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Regarding the objection to claim 11:

Applicants have amended claim 11 to more clearly define the present invention and to address the Examiner's concerns over allegedly confusing language. Applicants amended claim 11 to recite, *inter alia*, "said ceramic sheet is made of a magnetic ceramic for forming said central conductors," which Applicants deem in line with the Examiner's suggestion on p. 2 of the Office Action. Applicants therefore deem the objection to claim 11 overcome.

Regarding the rejection of claims 5 and 8 under 35 U.S.C. § 112, 1st ¶:

Regarding the rejection of claims 5 and 8 under 35 U.S.C. § 112, 1st paragraph, Applicants dispute the Examiner's allegation that

"[claims 5 and 8 contain] subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification needs to disclose how the same conductor plate as recited in claim 5 integrally forms the terminal electrodes and at least one of the input/output terminals. ... With respect to claim 8, the feature ... needs to be disclosed because it is not clear ... [and would require] undue experimentation or speculat[ion] in order to make and use the claimed invention" (Office Action, p. 2).

Contrary to the Examiner's allegation, Applicants' specification does describe all claimed subject matter in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response, Applicants point out to the Examiner exemplary descriptions in the specification contained, for example, on p. 9, l. 17 – p. 10, l. 22, p. 11, l. 23 – p. 12, l. 11, and p. 12, l. 22 – p. 13, l. 3, which more than reasonably describe the subject matter of claims 5 and 8.

In making various references to the specification set forth herein, it is understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification and illustrated in the drawings. Rather, Applicants

expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law. Applicants respectfully point out to the Examiner that “[e]ach claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description.” M.P.E.P. § 2163(II)(A)(1), 8th Ed., Aug. 2001, p. 2100-159.

In light of the abovementioned exemplary descriptions contained in the specification, Applicants therefore submit that the Examiner has not met his “initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” M.P.E.P. § 2163.04, pp. 2100-168 – 2100-169.

Finally, Applicants submit that, for the reasons already presented above, all subject matter in “the specification conveys with a reasonable clarity to those skilled in the art that, as of the filing date sought, applicant[s] [were] in possession of the invention as now claimed” (M.P.E.P. § 2163, 8th Ed., Aug. 2001, p. 2100-158). Claims 5 and 8 fully comply with the requirements of 35 U.S.C. § 112, 1st paragraph, and Applicants accordingly request withdrawal of that rejection.

Regarding the rejection of claims 7 and 9 under 35 U.S.C. § 112, 2nd ¶:

Regarding the rejection of claims 7 and 9 under 35 U.S.C. § 112, 2nd paragraph, Applicants have amended claims 7 and 9 to more clearly define the present invention, ensuring proper antecedent basis exists for “ground electrode” and “terminal electrodes” (claim 7), and for “electrode patterns” (claim 9). Applicants therefore deem the rejection of claims 7 and 9 overcome. Claims 7 and 9 fully comply with the requirements of 35 U.S.C. § 112, 2nd paragraph, and Applicants accordingly request withdrawal of that rejection.

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Regarding the rejection of claims 1, 2, 13, 17, and 18 under 35 U.S.C. § 102(b):

Applicants respectfully traverse the rejection of claims 1, 2, 13, 17, and 18 under 35 U.S.C. § 102(b) as anticipated by JP '607.

Applicants point out that in order to properly establish that JP '607 anticipates Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131, p. 2100-69, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131, p. 2100-69. Regarding the 35 U.S.C. § 102(b) rejection, JP '607 does not teach each and every element of Applicants' present invention as claimed.

Applicants' independent claims 1 and 17 recite, *inter alia*,

"at least said matching capacitors being integrally constituted in a laminate module having a substantially flat lower surface, and said laminate module being disposed on a substantially flat surface of a composite base comprising an insulation member and conductor plates."

Applicants' claims 1 and 17 are clearly different from JP '607, in that JP '607 is directed to improving side electrodes (See, for example, JP '607, paragraphs [0014] and [0020] of the translation provided by the Examiner), and does not disclose at least the recitations of either of Applicants' independent claims 1 or 17 quoted above. Figs. 1 and 3 – 7 of JP '607 clearly do not show a "laminate module being disposed on a substantially flat surface of a composite base comprising an insulation member and conductor plates" (Applicants' claims 1 and 17), but instead show a laminate board (120, 60, 110, 18, 130, depending on the Fig./embodiment) on a shield case (124, etc.) with which a portion of center conductor 50 is connected. JP '607's

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lamine board is clearly not “disposed on a substantially flat surface of a composite base comprising an insulation member and conductor plates” (Applicants’ claims 1 and 17).

Since Applicants’ conductor plate 18 is formed almost on an entire upper surface of a laminate module 5 and a ground electrode 27 is also formed almost on an entire lower surface of the laminate module 5 (see Applicants’ Figs. 1 – 3), when the laminate module 5 and the central conductor assembly 4 are mounted successively onto the resin-conductor composite base 6, not only the lower surface of the central conductor assembly 4 (having a ground conductor on a lower surface of the garnet member 12 thereof) (see p. 17, ll. 9 – 12 of Applicants’ specification), but also the ground electrode 27 can be almost entirely connected to the conductor plate 18 of the composite base 6, thereby facilitating the assembling and providing good connection of the ground electrode and the terminal electrodes without loss. In contrast to the present invention, JP ‘607 discloses that an outcrop 72 of a case 72 is connected with a conductor 54 via a lower surface of a central conductor assembly 50 and also electrode patterns 62D – 62E of volume 60 for grounding are connected to the side electrodes 66D – 66E, respectively, which are connected with side terminal electrodes 74D – 74E, respectively, for forming each connection of 66D – 74D and 66E – 74E, thereby resulting in unstable ground connection with great loss. See JP ‘607, par. [0021]. Therefore, JP ‘607 is clearly different from Applicants’ claimed invention.

Thus, JP ‘607 does not anticipate Applicants’ claimed invention. In addition to JP ‘607 not anticipating the present invention, as just pointed out, for a proper 35 U.S.C. § 102 rejection, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim,” and “[t]he elements must be arranged as required by the claim.” M.P.E.P. §2131, p. 2100-69, citations omitted. JP ‘607 does not disclose an identical invention, let alone in as complete detail as contained in either of Applicants’ independent claims 1 and 17. Applicants submit that the

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Examiner has not met these essential requirements of anticipation for a 35 U.S.C. § 102(b) rejection. Therefore, the rejection is improper and should be withdrawn.

Since JP '607 does not disclose each and every element of Applicants' present invention, JP '607 does not anticipate independent claims 1 and 17. Therefore, Applicants respectfully submit that claims 1 and 17 are patentable over JP '607, as are claims 2, 14, and 18, at least by virtue of their dependence from allowable base claims 1 and 17, respectively.

Regarding Item 8, p. 4, of the Office Action (joint inventors):

To address item 8, p. 4 of the Office Action, Applicants submit that the subject matter of the pending claims was commonly owned both at the time any inventions covered therein were made and at the present time.

Regarding the rejection of claims 3 and 9 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 3 and 9 under 35 U.S.C. § 103(a) as unpatentable over JP '607 in view of JP '702.

Applicants respectfully disagree with the Examiner's arguments and conclusions. A *prima facie* case of obviousness has not been made, since the Examiner does not show that all the elements of Applicants' claims are met in the cited references, and does not show that there is any suggestion or motivation to modify the cited references to result in the claimed invention. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ... If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.03, p. 2100-26.

Furthermore, regarding dependent claims 3 and 9, "Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim." M.P.E.P. § 608.01(n)(III), p.

600-77. JP '702, taken alone or in combination with JP '607, still does not teach or suggest those recitations of Applicants' independent claim 1 not taught or suggested by JP '607.

Applicants have already demonstrated above in that JP '607 does not teach or suggest all the recitations of Applicants' independent claim 1, and therefore, for at least the reasons stated above, Applicants' claims 3 and 9 are not obvious.

In addition, the Examiner admits deficiencies in JP '607, in that it "does not disclose multiple electrode patterns connected by via electrodes ... nor a ground pattern on the lower surface of the laminate module 60" (Office Action, p. 4), yet alleges "it would have been obvious ... to have substitute the art-recognized [features] of [JP '702] in place of the non-reciprocal device of [JP '607] because such a substitution ... would have advantageously allowed for larger sized capacitors" (Office Action, p. 5). (Applicants assume the Examiner meant "smaller capacitors with larger capacitance.") Applicants note, however, that JP '702 has ground conductors 81 and 82 above and below laminating capacitor layers 801 – 803, as evidenced in Fig. 2 of JP '702. Thus, these conductors cannot be Applicants' claimed:

"[said laminate module has] a ground electrode for connecting said capacitors to a ground on a substantially entire lower surface thereof, said ground electrode of said laminate module being disposed directly on a substantially entire upper surface of a ground electrode of said composite base and electrically connected thereto" (Applicants' claim 3); or "electrode patterns in said laminate module are connected though via-electrodes and/or side surface electrodes" (Applicants' amended claim 9).

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See M.P.E.P. §§ 2142, 2143, and 2143.03.

Even though JP '607 does not teach or suggest all the features of Applicants' claimed invention, the Examiner's application of JP '607 as a reference does not render the recitations of

Applicants' claims obvious. Even if the Examiner's characterization of JP '607 (see Office Action, pp. 4 – 5) were correct (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP '607 with JP '702.

Applicants respectfully point out to the Examiner that it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120.

Furthermore, there is no suggestion or motivation to modify JP '607 to produce Applicants' claimed invention. Even if the Examiner's allegations that "it would have been obvious" (Office Action, p. 5), were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP '607 to produce Applicants' claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original).

Since JP '607 and JP '702, taken alone or in combination, do not teach or suggest all the recitations of Applicants' claimed invention, and there can be no suggestion or motivation in the cited references to modify JP '607 with JP '702. Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants' present invention.

The Examiner seems to rely on JP '607, despite the fact that JP '607 is directed to a different way of making a non-reciprocal circuit device. Applicants submit that the Examiner is improperly applying JP '607 to Applicants' claims, despite its obvious differences from the present claimed invention. The M.P.E.P. states that "[a] statement [by the Examiner] that

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modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the invention was made” because the references relied upon teach that all aspects of the claimed invention ... is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.”

M.P.E.P. § 2143.01, p. 2100-124 (citations omitted, emphasis in original). In addition to the fact that JP ‘607 does not teach or suggest all the recitations of Applicants’ claimed invention and is directed toward a different way of making a non-reciprocal circuit device, JP ‘607 does not provide the requisite motivation for its modification with JP ‘702, or any reasonable expectation of success from so doing. Applicants have already established that JP ‘607 does not teach or suggest Applicants’ claimed invention. Applicants further submit that, according to the M.P.E.P., the Examiner’s citation of JP ‘607 in combination with JP ‘702 is not sufficient for the Examiner to establish *prima facie* obviousness.

Thus, dependent claims 3 and 9 are allowable for the reasons presented herein, in addition to being allowable at least by virtue of their dependence from allowable base claim 1. Therefore, Applicants respectfully submit that the Examiner should withdraw the improper 35 U.S.C. § 103(a) rejection.

Regarding the rejection of claims 4 – 8 and 16 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 4 – 8 and 16 under 35 U.S.C. § 103(a) as unpatentable over JP ‘607 in view of Yamamoto.

Applicants respectfully disagree with the Examiner’s arguments and conclusions. A *prima facie* case of obviousness has not been made, since the Examiner does not show that all the elements of Applicants’ claims are met in the cited reference, and does not show that there is any suggestion or motivation to modify the cited reference to result in the claimed invention.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be

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taught or suggested by the prior art. ... If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03, p. 2100-26.

Furthermore, regarding dependent claims 4 – 8 and 16, “Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim.” M.P.E.P. § 608.01(n)(III), p. 600-77.

Applicants have already demonstrated above in that JP ‘607 does not teach or suggest all the recitations of Applicants’ independent claim 1. Therefore, for at least the reasons stated above, Applicants’ claims 4 – 8 and 16 are not obvious over JP ‘607 standing alone. Moreover, Yamamoto, taken alone or in combination with JP ‘607, still does not teach or suggest those recitations of Applicants’ independent claim 1 not taught or suggested by JP ‘607.

Furthermore, the Examiner *admitted additional deficiencies in JP ‘607*, stating that JP ‘607 “does not disclose the electrical resistance of the “plates”” (Office Action, p. 5). In addition, Applicants note, despite the Examiner’s subsequent allegations that “it would have been obvious ... to have added a coating having a low resistance to the yoke” (Office Action, p. 5, cited to allegedly cure JP ‘607’s deficiencies), that Yamamoto’s and JP ‘607’s disclosures are still not combinable to produce Applicants’ claimed invention, in part because the magnetic yokes of JP ‘607 and Yamamoto have different structures. For example, Yamamoto’s “magnetic yoke also serves as a case” (Yamamoto, col. 5, l. 21), which is clearly different from both JP ‘607 and Applicants’ claimed invention. Moreover, JP ‘607 teaches “a magnetic yoke between cases 72” (JP ‘607, translation paragraph [0023]). Thus, in addition to the fact that Yamamoto does not cure the deficiencies of JP ‘607, Yamamoto and JP ‘607 cannot be combined to produce Applicants’ claimed invention.

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The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. §§ 2142, 2143, and 2143.03.

Even though JP ‘607 does not teach or suggest all the features of Applicants’ claimed invention, the Examiner’s application of Yamamoto as a reference in combination with JP ‘607 does not render the recitations of Applicants’ claims obvious. Even if the Examiner’s characterization of JP ‘607 (see Office Action, pp. 4 – 5 and pp. 5 – 6) were correct (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP ‘607 with Yamamoto. Applicants respectfully point out to the Examiner that it “is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” See In re Wesslau, supra. See also M.P.E.P. § 2141.02, p. 2100-120.

Furthermore, there is no suggestion or motivation to modify JP ‘607 with Yamamoto to produce Applicants’ claimed invention. Even if the Examiner’s statements that “it would have been obvious” (Office Action, p. 5), were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP ‘607 to produce Applicants’ claimed invention. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01, p. 2100-124, citing *In re Mills, supra*.

Since JP ‘607 and Yamamoto, taken alone or in combination, do not teach or suggest all the recitations of Applicants’ claimed invention, there can be no suggestion or motivation in the cited references to modify JP ‘607. Applicants submit that the cited references do not suggest the desirability of their modification to produce Applicants’ present invention.

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In addition to the fact that JP '607 does not teach or suggest all the recitations of Applicants' claimed invention and is directed toward a different way of making a non-reciprocal circuit device, JP '607 does not provide the requisite motivation for its modification with Yamamoto or any reasonable expectation of success from so doing. While Applicants have already established that JP '607 does not teach or suggest Applicants' claimed invention, Applicants submit that, according to the M.P.E.P., the Examiner's citation of JP '607 in combination with Yamamoto is not sufficient for the Examiner to establish *prima facie* obviousness.

Applicants have demonstrated above that the Examiner: (a) has not shown all recitations of Applicants' claimed invention are taught or suggested by JP '607 and Yamamoto, taken alone or in combination; (b) has not shown any requisite motivation to modify JP '607 with Yamamoto to produce Applicants' claimed invention; and (c) has not shown there would be any reasonable expectation of success from modifying JP '607 and/or Yamamoto in order to produce the present claimed invention. Thus, Applicants submit that the Examiner's reliance on JP '607 and Yamamoto fails to establish *prima facie* obviousness.

Thus, dependent claims 4 – 8 and 16 are allowable for the reasons presented herein, in addition to being allowable at least by virtue of their dependence from allowable base claim 1. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejection.

Finally, Applicants note the contradictory statements in the first full paragraph of page 6 of the Office Action pertaining to the rejection discussed in this section of the Amendment. The Examiner alleges "that process steps such as "integrally molded" are given patentable weight insofar as these process steps affect the final structure," yet then alleges that " "integrally molded" is given no weight because the resin composite 74 is attached to the plates 72 thereby

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yielding an integral structure.” This second allegation implies that a final structure has been obtained, which in turn implies that “integrally molded” is given patentable weight. In any event, Applicants respond to the Examiner’s statements to satisfy their burden of completely responding to the Office Action, but at the same time do not acquiesce to the Examiner’s apparently contradictory allegations. See M.P.E.P. §§ 714.02, 714.03.

Regarding the rejection of claims 10 – 12, 14, and 15 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 10 – 12, 14, and 15 under 35 U.S.C. § 103(a) as unpatentable over JP ‘607 in view of Marusawa.

Applicants respectfully disagree with the Examiner’s arguments and conclusions. A *prima facie* case of obviousness has not been made, since the Examiner does not show that all the elements of Applicants’ claims are met in the cited reference, and does not show that there is any suggestion or motivation to modify the cited reference to result in the claimed invention. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ... If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03, p. 2100-26.

Furthermore, regarding dependent claims 10 – 12, 14, and 15, “Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim.” M.P.E.P. § 608.01(n)(III), p. 600-77. Marusawa, taken alone or in combination with JP ‘607, still does not teach or suggest those recitations of Applicants’ independent claim 1 not taught or suggested by JP ‘607.

Applicants have already demonstrated above in that JP ‘607 does not teach or suggest all the recitations of Applicants’ independent claim 1, and therefore, for at least the reasons stated above, Applicants’ claims 4 – 8 and 16 are not obvious.

In addition, the Examiner admits further deficiencies in JP '607, in that it "does not disclose a laminate magnetic body with the central conductors located therein" (Office Action, p. 6), yet alleges "it would have been obvious ... to have substituted the magnetic body/central conductors of Yamamoto et al. in place of the magnetic body/central conductors in the non-reciprocal device of [JP '607]..." (Office Action, p. 6). (Applicants assume the Examiner meant "Marusawa" instead of "Yamamoto" in the above-quoted portion of the Office Action.) Applicants note, however, that Marusawa focuses on the center electrodes of a microwave non-reciprocal circuit element and not on Applicants' claimed features of the present invention that are not taught or suggested by JP '607. Thus, in addition to the fact that Marusawa does not cure the deficiencies of JP '607, Marusawa is clearly different from Applicants' claimed invention.

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See M.P.E.P. §§ 2142, 2143, and 2143.03.

Furthermore, the Examiner's application of Marusawa as a reference in combination with JP '607 does not render the recitations of Applicants' claims obvious. Even if the Examiner's characterization of JP '607 (see Office Action, pp. 4 – 5 and pp. 5 – 6) were correct (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP '607 with Marusawa. Applicants again respectfully point out to the Examiner that it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, supra. See also M.P.E.P. § 2141.02, p. 2100-120.

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Furthermore, there is no suggestion or motivation to modify JP '607 with Marusawa to produce Applicants' claimed invention. Even if the Examiner's statements that "it would have been obvious" (Office Action, p. 5), were true (which Applicants dispute), this still does not establish that there would have been the requisite suggestion or motivation to modify JP '607 with Marusawa to produce Applicants' claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, citing *In re Mills*, supra.

Since JP '607 and Marusawa, taken alone or in combination, do not teach or suggest all the recitations of Applicants' claimed invention, there can be no suggestion or motivation in the cited references to modify JP '607. Applicants submit that the cited reference does not suggest the desirability of its modification to produce Applicants' present invention, or any reasonable expectation of success from so doing.

Applicants have demonstrated above that the Examiner: (a) has not shown all recitations of Applicants' claimed invention are taught or suggested by JP '607 and Marusawa, taken alone or in combination; (b) has not shown any requisite motivation to modify JP '607 with Marusawa to produce Applicants' claimed invention; and (c) has not shown there would be any reasonable expectation of success from modifying JP '607 and/or Marusawa in order to produce the present claimed invention. Thus, Applicants submit that the Examiner's reliance on JP '607 and Marusawa fails to establish *prima facie* obviousness.

Thus, dependent claims 10 – 12, 14, and 15 are allowable for the reasons presented herein, in addition to being allowable at least by virtue of their dependence from allowable base claim 1. Therefore, Applicants respectfully submit that the Examiner should withdraw the improper 35 U.S.C. § 103(a) rejection.

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Conclusion:

In view of the foregoing, Applicants submit that the objections to, and rejections of, the claims, as detailed in the previous sections above, are improper and should be withdrawn.

Applicants submit that pending claims 1 – 18 are in condition for allowance, and accordingly request a favorable action.

Please grant any extensions of time under 37 C.F.R. § 1.136 required in entering this response. If there are any fees due under 37 C.F.R. § 1.16 or 1.17, which are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 9, 2002

By: 

Bruce C. Zotter
Reg. No. 27,680

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APPENDIX TO AMENDMENT OF October 9, 2002

Version of Specification with Markings to Show Changes Made

AMENDMENTS TO THE SPECIFICATION:

Please replace the paragraph beginning on page 10, line 3, with the following new paragraph:

--With this structure, the lower surface of the laminate module is in close contact with the ground electrode (conductor plate) of the composite base and directly soldered to each other. The ground electrode (conductor plate) on a lower surface of the composite base is in close contact with the upper surface of the lower base and directly soldered to each other. Because this provides a wide contact area, the insertion loss is decreased, thereby providing good connection of the ground electrode and the terminal electrodes without loss. Further, it provides [geed] good characteristics of attenuating second and third harmonic, and improved mechanical strength. Thus, the close contact of the laminate module and the resin-conductor composite base to the lower case without gap is an important feature of the present invention.--

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APPENDIX TO AMENDMENT OF OCTOBER 9, 2002

“VERSION OF CLAIMS WITH MARKINGS TO SHOW CHANGES MADE”

AMENDMENTS TO THE CLAIMS:

Please amend claims 7, 9, and 11 as follows:

7. (Amended) The non-reciprocal circuit device according to claim 4, wherein [said] a ground electrode and [said] terminal electrodes of said resin-conductor composite base have contact surfaces in the same plane.

9. (Amended) The non-reciprocal circuit device according to claim 1, wherein [said] electrode patterns in said laminate module are connected through via-electrodes and/or side-surface electrodes.

11. (Amended) The non-reciprocal circuit device according to claim 10, wherein said ceramic sheet is made of a magnetic ceramic for forming said central conductors.

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